

REMARKS

In the present Office Action, claims 1-7 and 9-14 were pending before the Office. Of these, claims 1, 12, and 14 were the only independent claims.

Claims 1-7 and 9-14 were rejected under 35 U.S.C. § 103(a).

Independent claims 1, 12, and 14 are hereby amended. No new matter is hereby added. Approval and entry of the amendments are respectfully requested. No claims are hereby added, canceled, or withdrawn.

A. CLAIM REJECTION UNDER 35 U.S.C. § 103 OF CLAIMS 1-5 AND 12-14

Claims 1-5 and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,671,267 to August et al. [hereinafter August] in view of U.S. Patent No. 4,899,370 to Kameo et al. [hereinafter Kameo]. In the interest of expediting prosecution, independent claims 1, 12, and 14 have been amended. Reconsideration and withdrawal of the rejection are respectfully requested.

Independent claim 1 now recites, *inter alia*:

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command, wherein the telephone line is directly coupled to the set top box, wherein the receiving of the telephone call is performed by the set top box, and

wherein the at least one command is transmitted directly to the set top box.

Independent claims 12 and 14, which each have their own scope, have similarly been amended.

It is respectfully submitted that the citations to *August* and *Kameo* have not been shown to disclose the above features in combination. Rather, *August* in Fig. 5 shows a system including a handset unit 10 that "provides the remote control functions for this video receiving device as well as the set-top box 32." The citation to *August* does not appear to expressly state that a caller can call in to a set top box directly and transmit a command directly to the set top box, the controlling including directing the set top box to tune to a television event in accordance with the at least one command. *Kameo* in Fig. 2 shows a system including a "care-taking telephone set 20A" connected to a "remote control transmitter unit 14". The citation to *Kameo* does not appear to expressly state that a caller can call in to a set top box directly and transmit a command directly to the set top box, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

It is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness.

Moreover, it is respectfully submitted that the Office Action has provided no reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way Applicants' claims 1-5 and 12-14 do. As noted in the Office's own examination manual, the United States Supreme Court indicated that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *MPEP* § 2143 (citing *KSR International Co. v. Teleflex Inc.*, 550

U.S. 398, 418, 82 USPQ2d 1385, 1395-97 (2007)). Simply stating a benefit of Applicants' claims does not provide any insight, reasoning, or logic that could be properly called "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" and is mere hindsight reconstruction. While inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known, simply finding claim features piecemeal in the prior art references and stating an object from one of the cited references does not provide the reasoning required to maintain a *prima facie* case of obviousness.

The Office Action merely states that it would have been obvious to combine the teachings "to provide a set top box that a user has full control of the set top box over a telephone call." *Office Action*, page 3. The citations to *August* and *Kameo* - and the Office Action - fail to provide a reason as to why one of skill in the art would be motivated to make such a combination.

In view of the above, it is respectfully submitted that the Office Action has provided no reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way Applicants' claims 1-5 and 12-14 do.

If view of at least the above two reasons, reconsideration and withdrawal of the §103 rejection are respectfully requested.

B. CLAIM REJECTIONS UNDER 35 U.S.C. § 103 OF CLAIMS 6, 7, AND 9-11

Claims 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of *Kameo*, further in view of U.S. Patent No. 6,772,436 to Doganata et al. [hereinafter *Doganata*]. Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of *Kameo*, further in view of

U.S. Patent Publication No. 2005/0028208 to Ellis et al. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over August in view of *Kameo*, further in view of U.S. Patent No. 5,640,453 to Schuchman. Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over August in view of *Kameo*, further in view of U.S. Patent No. 6,219,355 to Brodigan.

It is respectfully submitted that the record fails to establish that the various tertiary citations add anything that would remedy the above discussed deficiencies in the primary and secondary citations to *August* and *Kameo*. Thus, each of the proposed combinations of citations fails to disclose each and every feature of the claims.

Moreover, it is respectfully submitted that the Office Action has provided no reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way Applicants' claims 6, 7, and 9-11 do. Simply, for example, stating an object from one of the cited references does not provide any insight, reasoning, or logic that could be properly called "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" and is mere hindsight reconstruction.

The Office Action merely states that it would have been obvious to combine the teachings, for example, "because it enables viewers to participate in audio conferences that are linked to the programs that they are watching, without the need to dial in to a conference call." Office Action, pages 6-7. The citations to, for example, *August*, *Kameo*, *Doganata* - and the Office Action - fail to provide a reason as to why one of skill in the art would be motivated to make such a combination.

In view of the above, it is respectfully submitted that the Office Action has provided no reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way Applicants' claims 6, 7, and 9-11 do.

In view of at least the above two reasons, reconsideration and withdrawal of the \$103 rejections are respectfully requested.

C. CONCLUSION

Since, for at least the above reasons, it is respectfully submitted that all the independent claims are in condition for allowance and all remaining claims properly depend from the independent claims, it is respectfully submitted that all claims are allowable.

It is not believed that a request for extension of time is required but if it is, please accept this paragraph as a request for an extension of time and authorization to charge the requisite extension fee to Deposit Account No. 04-1696. It is not believed that any additional fees are due regarding this amendment. However, if any additional fees are required, please charge Deposit Account No. 04-1696.

Respectfully submitted,



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